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REMARKS

Claims 1 to 24 were pending in the application at the time of examination. Claims 1 to 24 stand rejected as obvious.

Applicants respectfully request withdrawal of the final designation in the pending office action. The Examiner has presented in the Final Office Action for the first time new rejections of all claims. In each case, the Examiner has cited a new combination of references that includes U.S. Patent No. 5,867,678, which was first cited in the Final Office Action.

Also, the Examiner has regrouped Claims in the Final Office Action. For example, in the first action, the Examiner treated Claims 1 to 5, 7 to 19, 22 and 24 as a group. In the Final Office Action, Claims 7 and 24 were removed from this group and a new separate rejection presented.

The MPEP directs:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant. . . . Switching . . . from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.
>
> . . . .
>
> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

MPEP §706.07, 8th Edition, Rev 1, p 700-71 (Feb. 2003).

The claims in the instant action were "claims of substantially the same subject matter" as in the first action. Apparently, it was the deficiency of the secondary reference in

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the first action that caused the Examiner to cite additional references. The Examiner gave no rationale why it was necessary to treat Claims 7 and 24 differently in the Final Office Action or why it was necessary to rely upon new references. Accordingly, in view of the above directions in the MPEP, the final rejection is premature, because new sets of references were used, and new rejections were provided for each and every claim. Thus, at this time "a clear issue" has not been developed. Applicants respectfully request reconsideration and withdrawal of the final designation of the action.

Claims 1 to 5, 8 to 19, and 22 to 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,342 B1, hereinafter Lawrence, in view of U.S. Patent No. 5,867,678, hereinafter Amro.

The Examiner restated nearly verbatim the rejection based on Lawrence:

> Regarding claims 1, 12, 15, and 22, **Lawrence et al.** teaches a method, computer program, and storage medium for creating a reference database for a computer-readable document comprising:
> a). entering inputted reference data into a reference database (col. 6, lines 42-52; and
> b). storing the reference database and other data of the computer-readable document wherein said other data includes at least one citation to said user inputted reference data (col. 8, lines 12-17).
> **Lawrence et al.** does not explicitly teach a step of storing the **reference database and other data** of the computer-readable document in a **single data file.** (Emphasis in original.)

The Examiner further stated:

> **Amro et al.**, however, teaches a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc. . . (col. 4, lines 4-7).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to store document related data in the same file because doing so would ensure that reference data is always available for access.

In addition, in continuing the reliance on the primary reference, the Examiner stated:

> . . .Lawrence utilizes the help of an assistant agent to perform tasks on **behalf of the user,** making interaction with the software system easier and/or more efficient (col. 5, lines 20-25). Since the user instructs the assistant agent to find, extract, and store the citation information, it is equivalent to that of the user performing the tasks on his/her own. (Emphasis in original.)

The Examiner has cited no reference for the conclusion that follows the description of an assistant agent. Lawrence stated, "the present invention does not require any extra effort on the part of the authors beyond placement of their work on the web." Thus, contrary to the Examiner's statement above, Lawrence stated that the author's, e.g., the user that inputs data into the document, only action was "placement of their work on the web."

The Examiner apparently misinterprets the purpose of Lawrence. Lawrence is not concerned with processing of a citation that is input by a user into a particular document, but instead with generating a citation index for a collection of documents. The citation index is then used in research, for example. Lawrence unambiguously stated:

> An Autonomous Citation Index autonomously creates a citation index from literature in electronic format.

Lawrence, Col. 5, lines 50, 51.

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This index is generated automatically and is searchable by the user. In particular, Lawrence further stated:

> The autonomous citation indexing system 10 comprises three main components: (i) a "crawler" module 12 for the automatic location and acquisition of publications, (ii) a document parsing and database creation module 14, and (iii) a query processing module 16 which supports search by keyword and browsing by citation links through a web browser interface 18 to the world wide web.

Lawrence, Col. 7, lines 29 to 35.

There is no indication in this description of the system of the actions stated by the examiner. Searching by keyword and browsing by citation links is unrelated to entering user input data as recited in the claims.

The MPEP requires:

> PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

MPEP § 2141.02, 8th Edition, Rev 1, p 2100-120 (Feb. 2003).

In view of the express description of the actions taken by an author of the document, Lawrence taken as a whole fails to suggest or teach any action concerning reference data that is input by a user into a computer readable document.

Nevertheless, the Examiner asserts, as quoted above, that based upon Amro, Lawrence would be modified to store the data in a particular way. The problem is that Lawrence is not creating a document. Lawrence explicitly states that the author places the document of the World Wide Web and Lawrence generates a searchable citation index using documents placed on the World Wide Web.

Again, Applicants note the MPEP states:

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THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP § 2143.02, 8th Ed. Rev 1., p. 2100-127, (Feb. 2003).

Changing an autonomous citation indexing system that finds and generates a citation index to reformat documents and store new information in such documents would require a change in the principle of operation of Lawrence. Similarly, modifying the other index system mentioned in Lawrence and cited by the Examiner would suffer from similar problems. In particular, the fact that Lawrence would have to modify every document found on the World Wide Web shows the impracticality of the modification. Lawrence is addressing a completely different problem than the problem addressed by Applicants.

Therefore, Applicants respectfully submit that in view of the directive of the MPEP, the obviousness rejection of Claim 1 is not well founded for multiple reasons. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 5, 8 and 9 depend from Claim 1 and distinguish over the combination of references for at least the same reasons as Claim 1. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 5 and 8 to 9.

Claim 6 stands rejected as obvious in view of Lawrence and Amro taken together with U.S. Patent No. 5,097,418, hereinafter Nurse. However, assuming that the combination of the three

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references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1 and incorporated herein by reference. In particular, there is no basis for modifying Lawrence, because Lawrence stated explicitly that the user provided the document. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 6.

The obviousness rejection of Claim 10 relied upon the same information as discussed above for Claim 1. Claim 10 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 10 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 10.

Claim 11 depends from Claim 10 and so distinguishes over the combination of references for at least the same reasons as Claim 10. In addition, the text cited by the examiner described operation of a parsing module, which again is unrelated to anything recited in Claim 11. Downloading and then parsing a document is unrelated to the apparatus recited in Claim 11. Again, the MPEP requires that the claims be considered as a whole and not be distilled to a gist. See MPEP § 2141.02, p. 2100-121. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 11.

The obviousness rejection of Claim 12 relied upon the same information as discussed above for Claim 1. Claim 12 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 12 and is incorporated herein by reference.

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Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 and 14 depend from Claim 12 and so distinguish over the combination of references for at least the same reasons as Claim 12. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 13 and 14.

The obviousness rejection of Claim 15 relied upon the same information as discussed above for Claim 1. Claim 15 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 15 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claims 16 to 19 depend from Claim 15 and so distinguish over the combination of references for at least the same reasons as Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejections of each of Claims 16 to 19.

In the obviousness rejection of Claim 20, the Examiner cited an additional reference. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 20.

Claim 21 depends from Claim 20 and so distinguishes over the combination of references for at least the same reasons as Claim 20. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 21.

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The obviousness rejection of Claim 22 relied upon the same information as discussed above for Claim 1. Claim 22 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 22 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 22.

Claim 23 depends from Claim 22 and so distinguishes over the combination of references for at least the same reasons as Claim 22. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 23.

Claims 7 and 24 stand rejected in view of Lawrence, Amro, and Kanerva, which was used in the first rejection. Again, this rejection requires the same combination of references as in Claim 1 and then looking to yet a third reference that describes another unrelated system, as previously pointed out. The above discussion with respect to Lawrence and Amro is incorporated herein by reference, as is the discussion of Kanerva in the prior response. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 7 and 24.

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Reply to Office Action of December 12, 2003

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Claims 1 to 24 remain in the application. For the foregoing reasons, Applicants respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicants.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on the date shown below.

Mona J. Marshall — March 10, 2004

Mona J. Marshall — Date of Signature

Respectfully submitted,

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